

under 35 USC §112. The applicant added new claims 45-50, 54, 59-62, and 64 in an amendment dated 16 June 2003, and the claims addressed in the Decision on Appeal were not amended.

MPEP §1214.04 addresses the reversal of an examiner's rejection by the Board and reads in part:

"If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection....The TC Director's approval is placed on the action reopening prosecution." MPEP §1214.04.

The applicant respectfully submits that the Office Action dated 8 October 2003 is reopening prosecution under 35 USC §112 of claims 23-25, 29, 30, 38, and 44, subsequent to the Decision on Appeal, and does not have the TC Director's approval as is required by MPEP §1214.04. The applicant respectfully requests that the TC Director's approval for this rejection be placed on the Office Action, or the rejection be withdrawn.

Regarding the new claims 45-50, 54, 59-62, and 64, claim 45 recites features also recited in claim 24; claims 46, 54, and 64 recite features also recited in claim 29; claims 47 and 49 each have elements from claim 23 combined with claim 24; claims 48 and 50 recite features also recited in claim 25; claims 59 and 61 each have elements from claim 30 combined with claim 31; and claims 60 and 62 recite features also recited in claim 31.

The applicant respectfully submits that claims 23-25, 29, 30, 38, 44-50, 54, 59-62, and 64 are in condition for allowance.

Rejections of Claims Under §102 and §103

Claims 26-28, 31, 36, 37, 39-45, 51-53, 63, 65, and 23, 24, 47, and 49 were rejected under 35 USC § 102(e) as being anticipated by Park et al. (U.S. Patent No. 5,545,578, Park).

Claims 26-28, 31, 36, 37, 39, 42, 44, 45, 51-53, 63, 65, and 23, 24, 47, and 49 were rejected under 35 USC § 102(e) as being anticipated by Hsu et al. (U.S. Patent No. 5,796,151, Hsu).

Claims 25, 29, 30, 38, 46, 48, 50, 54, 59-62, and 64 were rejected under 35 USC § 102(e) as being anticipated by, or in the alternative, under 35 USC § 103(a) as being obvious over Park.

Claims 55-58 were rejected under 35 USC § 103(a) as being unpatentable over Park or Hsu in

view of Liao et al. (U.S. Patent No. 5,480,830, Liao). Claims 40, 41, and 43 were rejected under 35 USC § 103(a) as being unpatentable over Hsu in view of Park. The applicant respectfully traverses.

Claims 23-31 and 36-44 were rejected under 35 USC §103 in the rejection that was appealed to the Board of Patent Appeals and Interferences (Board) on 2 June 2000 by the applicant. The Board issued the Decision on Appeal on 26 February 2003 reversing the rejection under 35 USC §103. The applicant added new claims 45-65 in the amendment dated 16 June 2003, and the claims addressed in the Decision on Appeal were not amended.

The applicant respectfully submits that the Office Action dated 8 October 2003 is reopening prosecution of claims 23-31 and 36-44, subsequent to the Decision on Appeal, and does not have the TC Director's approval as is required by MPEP §1214.04. The applicant respectfully requests that the TC Director's approval for this rejection be placed on the Office Action, or the rejection be withdrawn.

Regarding the new claims 45-65, claims 45 and 46 are dependent on claim 41; independent claims 47 and 49 each have elements from claim 23 combined with claim 24, and claims 48 and 50 are dependent thereon; independent claims 51 and 55 each have elements from claim 26 combined with claim 28, and claims 52-54 and 56-58 are dependent thereon; independent claims 59 and 61 each have elements from claim 30 combined with claim 31, and claims 60 and 62 are dependent thereon; claims 63 and 64 are dependent on claim 39; and claim 65 is dependent on claim 42.

The applicant respectfully submits that claims 23-31 and 36-65 are in condition for allowance.

RESPONSE UNDER 37 CFR § 1.111

Serial Number: 08/902809

Filing Date: July 30, 1997

Title: SELECTIVE SPACER TO PREVENT METAL OXIDE FORMATION DURING POLYCIDE REOXIDATION

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Dkt: 303.278US1

CONCLUSION

The applicant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is requested to telephone the below-signed attorney at 612-373-6973 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

KLAUS F. SCHUEGRAF ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6973

Date 9 February 2004

By _____

Robert E. Mates
Reg. No. 35,271

fs/r

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 9 day of February, 2004.

Name

Tina Kohaut

Signature

Z.L.F.